REMARKS

Claims 18, 20-21, 23, 25-26, 29-32, 34, 36-37, 40, 42-43, 46-49, 63, 95, 97-98, 101, 103-104, 107-109, 111, and 134-145 were and are still pending. Claims 18, 20-21, 23, 25-26, 29-32, 34, 36-37, 40, 42-43, 46-49, 63, 134, and 138 are under examination in this application. No new matter has been added.

Rejections under 35 U.S.C. §112, first paragraph

Claims 18, 20-21, 23, 25-26, 29-32, 34, 36-37, 40, 42-43, 46-49, 63, 134, and 138 are rejected under 35 U.S.C. §112, first paragraph. The Examiner asserts that the specification, while being enabling for some of the claimed compounds, does not reasonably provide enablement for the full scope of the claims. The Examiner alleges that "[t]he specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, *to use* the invention commensurate in scope with these claims." (Emphasis added).

Applicant respectfully traverses the rejection and requests reconsideration. Section 2164.01(c) of the MPEP entitled "*How to Use the Claimed Invention*" sets the requirements for enabling *the use* of the claimed invention:

> "If a statement of utility in the specification contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are known and contemplated, 35 U.S.C. 112 is satisfied. *In re Johnson*, 282 F.2d 370, 373, 127 USPQ 216, 219 (CCPA 1960); *In re Hitchings*, 342 F.2d 80, 87, 144 USPQ 637, 643 (CCPA 1965). See also *In re Brana,* 51 F.2d 1560, 1566, 34 USPQ2d 1437, 1441 (Fed. Cir. 1993."
>
> "[W]hen a compound or composition claim is not limited by a recited use, any enabled use that would reasonably correlate with the entire scope of that claim is sufficient to preclude a rejection for non-enablement based on how to use."

The specification discloses that the claimed compounds "are useful in inducing cytokine biosynthesis in animals" (page 2, lines 5-6). Thus, the application, as filed, has a "statement of utility of how to use" the claimed compounds. Therefore, the requirement for enabling *the use* of the claimed compounds under 35 U.S.C. §112 is satisfied.

The application also teaches an established method of inducing cytokine biosynthesis by the compounds of the invention (page 172, line 3 - page 174, line 6), precluding a rejection for non-enablement based on *how to use*.

The Examiner has not provided any evidence that one skilled in the art could not have used the claimed compounds for the disclosed use without undue experimentation.

In view of the above arguments, withdrawal of the rejection under 35 U.S.C. §112, first paragraph, is respectfully requested.

CONCLUSION

In view of the above arguments, Applicant believes the pending application is in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time.

If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed payment, please charge any deficiency to Deposit Account No. 23/2825 under Docket No. C1271.70019US01 from which the undersigned is authorized to draw.

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Respectfully submitted,

By_____

Roque El-Hayek
Registration No.: 55,151
WOLF, GREENFIELD & SACKS, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
617.646.8000